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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,634	03/23/2001	Roni Koren	CD-1	7112
1473	7590	03/24/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/816,634	KOREN, RONI	
	Examiner	Art Unit	
	Stefano Karmis	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-174 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-174 is/are rejected.
- 7) ☒ Claim(s) 166-174 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/23 5/20</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following application has been reviewed. Original claims 1-174 are pending.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 166-173 have been renumbered 166-174.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 6, 8-14, 16, 17, 20-23, 25, 26, 28-34, 36, 37, 40-43, 45-51, 53, 54, 57-61, 63, 64, 66-72, 74, 75, 78-81, 83, 84, 86-92, 94, 95, 98-101, 103-109, 111, 112, 115-119, 121, 122, 124-130, 132, 133, 136-139, 141, 142, 144-150, 152, 153, 156-159, 161-167, 169, 170, 173

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and 174 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimada et al. (hereinafter Shimada) U.S. Patent 6,396,919.

Regarding claims 1, 59 and 117, Shimada discloses a transaction method comprising: registering at least one available transaction; assigning to said at least one available transaction a transaction code to be publicized (column 15, line 63 thru column 16, line 30); registering at least one user, said registering including recording payment information from each said at least one user (column 7, lines 37-45 and column 10, lines 16-20); assigning a personal identification code to each said at least one user (column 7, lines 54-67 and column 9, lines 20-33); accepting automatically an aural communication including said personal identification code and said transaction code (column 11, lines 30-60 and column 15, line 44 thru column 16, line 19); and arranging said at least one available transaction to be completed for said at least one user, including arranging to have payment collected based said recorded payment information (column 13, lines 54-64 and column 16, lines 31-38).

Claim 2, 60 and 118 wherein said accepting comprises accepting automatically an aural communication from any one of at least two communications networks that each provide communications based on a different communications protocol (column 5, line 66 thru column 6, line 41).

Claim 3, 23, 61, 81, 119 and 139 wherein said communication occurs over a landline telephonic aural telephone (column 6, lines 61-67).

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Claim 5, 25, 42, 63, 83, 100, 121, 141 and 158 wherein said registering at least one user includes recording at least one telephone number of said at least one user, said method further comprising detecting a telephone number from which said telephonic aural communication originates, and said accepting includes verifying that said telephonic aural communication originates from one of said at least one recorded telephone numbers of said at least one user (column 8, lines 1-7).

Claim 6, 26, 43, 64, 84, 101, 122, 142 and 159 wherein said registering at least one user includes recording at least one communications address of said at least one user, said method further comprising detecting a communications address from which said telephonic aural communication originates, and said accepting includes verifying that said telephonic aural communication originates from one of said at least one recorded communications addresses of said at least one user (column 15, lines 22-37).

Claim 8, 28, 45, 66, 86, 103, 124, 144 and 161 further comprising confirming that said at least one user desires said at least one available transaction (column 11, lines 20-60).

Claim 9, 29, 46, 67, 87, 104, 125, 145 and 162 further comprising accepting said telephonic aural communication as one number that is entered by said at least one user to include said personal identification code and said transaction code (column 14, lines 7-23 and column 10, line 63 thru column 11, line 60).

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Claim 10, 30, 47, 68, 88, 105, 126, 146 and 163 wherein said arranging comprises arranging said at least one available transaction automatically in response to said accepting (column 6, lines 10-23).

Claim 11, 31, 48, 69, 89, 106, 127, 147 and 164 wherein said aural communication is a voice communication.

Claim 12, 32, 49, 70, 90, 107, 128, 148 and 165 further comprising recognizing said personal identification code when said personal identification code is spoken in said aural voice communication, and wherein said accepting comprises accepting automatically said aural voice communication based on said recognizing (column 8, lines 50-64).

Claim 13, 33, 50, 71, 91, 108, 129, 149 and 166 wherein said registering at least one user comprises recording a signature of said at least one user speaking said personal identification code, said method further comprising comparing said signature with said personal identification code spoken in said aural voice communication, and said accepting comprising accepting automatically said aural voice communication based on said comparing (column 8, lines 50-64).

Claim 14, 34, 51, 72, 92, 109, 130, 150 and 167 wherein said at least one user is one of a plurality of registered users that each have a different user terminal platform and wherein said accepting comprises accepting aural communications from each of said different user terminal platforms.

Claims 16, 36, 53, 74, 94, 111, 132, 152 and 169 wherein said aural communication comprises dual-tone/multi-frequency entries (column 10, line 64 thru column 11, line 19).

Claims 17, 37, 54, 75, 95, 112, 133, 153 and 170, further comprising registering one transaction that is available from said at least one user when said at least one user is registered (column 15, line 63 thru column 16, line 30).

Claims 20, 40, 57, 78, 98, 115, 136, 156 and 173 wherein said registering at least one transaction comprises registering two transactions for two different locations, said assigning a transaction code comprises assigning to each of said two transactions said transaction code, said accepting comprises determining a location of said at least one user, and said method further comprising locating from where said communication is sent to identify one of said two transactions (column 15, line 63 thru column 16, line 30).

Claims 21, 41, 58, 79, 99, 116, 137, 157 and 174, wherein said personal identification code is a unique identification code (column 7, lines 54-67).

Claims 22, 80 and 138, wherein said aural communication is telephonic (column 6, lines 61-67).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 4, 7, 15, 18, 19, 24, 27, 35, 38, 39, 44, 52, 55, 56, 62, 65, 73, 76, 77, 82, 85, 96, 96, 97, 102, 110, 113, 114, 120, 123, 131, 134, 135, 140, 143, 151, 154, 155, 160, 168, 171 and 172 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al. (hereinafter Shimada) U.S. Patent 6,396,919.

Regarding claims 4, 15, 24, 35, 52, 62, 73, 82, 93, 110, 120, 131, 143, 151 and 168, Shimada teaches telephonic communications over a landline phone. Shimada further teaches that the network is a public network (column 6, lines 25-40), which performs switching functions (column 12, lines 27-43 and column 13, lines 21-35). However, Shimada fails to teach

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communications over a wireless phone. Official Notice is taken that communication over a wireless phone is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Shimada and include that the phone be a wireless phone because it allows for greater efficiency by allowing transactions to occur anywhere and the aural communications such as voice speaking is the same for a wireless phone as a LAN phone.

Regarding claims 7, 27, 44, 65, 85, 102, 123, 143 and 160, Shimada teaches that the user enters information during registration such as name and address. Shimada fails to specify that this information is used as shipping information. Official Notice is taken that an address used as shipping information is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Shimada and specify that the name and address are used as shipping information since it is the pertinent information to get the goods purchased from the seller to the buyer.

Regarding claims 18, 19, 38, 39, 55, 56, 76, 77, 96, 97, 113, 114, 134, 135, 154, 155, 171 and 172, Shimada teaches registering a user in the system. Shimada fails to teach registering a vendor and payment information associated with the vendor. Official Notice is taken that registering a vendor is old and well known in the financial arts. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to register vendors because it would provide for greater confidence when processing a transaction similar to the manner in which the registered customer information assists in providing secure transactions.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
16 March 2006



HANI M. KAZIMI
PRIMARY EXAMINER